

Response and Remarks

Prior to this amendment, Claims 1-49 were pending in this case.

Applicant has amended claims 1 and 21 to provide the proper antecedent basis, to remove vagueness, and to clarify the non-obviousness of the claims. These amendments are directed to the subject matter in the original claims, on p. 2 lines 4-18, p. 6, lines 8-16, and fig. 2. These amendments are discussed more fully below.

Applicant has amended claims 5 and 25 to clarify that they require two searches conducted by the same user and that the invention involves identifying results from the second search that were also responsive to the first. These claims are directed to the subject matter in the original claims and on p. 11, lines 8-19.

Applicant has amended claims 31 and 33 to clarify that they provide novel and non-obvious displays based on a novel and non-obvious way of sorting the search results. They are directed to the subject matter in the original claims and on p. 8, lines 7-21.

Applicants have added new Claims 50 to 73. Claims 50-51 are directed to the subject matter disclosed on p.11, lines 3-4. Claims 52-55 are directed to the subject matter disclosed on p.9, lines 15-18. Claims 56-57 are directed to the subject matter disclosed on p. 12., lines 3-9 and Fig. 3. Claims 58-59 are directed to the subject matter disclosed on p. 11, lines 2-3. Claims 60-61 are directed to the subject matter disclosed on p. 5, lines 14-15. Claims 62-65 are directed to the subject matter disclosed on p12, lines 10-13. Claims 66-67 are directed to the subject matter disclosed on p. 11, lines 14-16. Claim 68 is directed to the subject matter of p. 8, lines 19-21. Claims 69-71 are directed to the subject matter of p. 7, lines 13-24 to p.8, lines 1-6. Claims 72-73 are directed to the subject matter of p. 11, lines 1-7.

Applicants have amended Claims 1 and 21 to provide the proper antecedent basis, to overcome the Examiner's first rejection based on 35 U.S.C. § 112. Applicant has deleted the word "responsive" in the phrase "responsive records" that did not have a proper antecedent basis. To overcome the vagueness rejection, the applicant clarifies that the records under consideration all contain content elements and that the elements to be simultaneously displayed with the identifiers must be said content elements. Content elements are simply parts of the content of the record. For legal documents, the content elements are most often text elements. The Examiner is also referred to page 2, lines 9-10 and page 9, lines 11-18 for definitions of "element." For additional clarity, the Applicant amends the specification in these two instances to show that the elements considered are content elements. Claims 2-4, 6-20, 22-30 and 34-49 which depend from claims 1 and 21, respectively, are no longer vague based on the amendments to claims 1 and 21. Claims 5, 25, 31, and 33 have been otherwise amended to, among other things, remove any vagueness and demonstrate non-obviousness. Claim 32 depends from claim 31. The amendments directly resolve the Examiner's rejections, and the Applicants respectfully request that all rejections based on 35 U.S.C. § 112 be withdrawn.

The Examiner has also rejected Claims 1-49 under 35 U.S.C. § 103(a) as obvious over Barr et al., United States Patent No. 5,873,076 in view of Schmitt, United States Patent No. 6,463,431. The Examiner states although Barr does not teach the simultaneous display of a list of identifiers with selected elements, Schmitt teaches an interface that simultaneously displays a nearest neighbor item and a user selected item. Furthermore, the examiner states it would have been obvious to one of ordinary skill in the art to combine the two patents, because of Schmitt's ability to simultaneously display a list of items and selected items would allow the user to keep items that may have been overlooked.

Claims 1 and 21 have been amended to clarify that the invention requires the simultaneous display of identifiers of records along with content elements for the same records. Neither Barr, nor Schmidt teach the display of content elements. Since an essential element of the invention is missing in both, the combination of the art taught in the two patents cannot make the present invention obvious.

Barr teaches a way to query a database and a display of search results including the simultaneous display of identifiers and secondary bibliographic information. However, it does not teach the display of any element of the actual work that is identified. The portions of the patent identified by the Examiner support this conclusion. Element 206 of Fig. 2 of Barr refers to choosing an item from a results list, but does not address the display of the results list. Fig. 4A of Barr shows a display that includes the simultaneous display of identifiers (i.e., the names of particular movies or documents), relevance scores, and bibliographic information, but nowhere shows the display of any portion of the content of any record. Similarly, Fig. 5 shows a variety of information about a given document, but does not include any portion of the document itself. The portion of Barr cited by the Examiner in col. 12 refers to identifying documents and files relevant to a search query, but does not mention a display of content elements of those documents. The portion of Barr cited in col. 14 describes the display shown in Fig. 4A of Barr and discusses how the user may either select a document or perform a further search, but nowhere is there a mention of displaying any of the content of the documents or files.

As described in its abstract, Schmitt teaches a device that “simultaneously displays multiple levels of nearest neighbors for user selected attributes.” It does not teach displaying a document and a portion of the content of that document. Fig. 3 of Schmitt cited by the Examiner shows a method of selecting documents, not a way of displaying search results. The part of the

specification referenced by the Examiner in cols. 3-4 teaches two displays. One allows the user to select attributes of items retrieved from a database in order to reduce the result set. For example, cars may be selected based on certain attributes, such as performance, safety, and reliability. There is also a “graphical slider” that the user can use to specify attribute weightings. See fig. 4, col. 3 line 50 of Schmitt. However, no part of the content elements are displayed along with the attributes. Schmitt teaches a second display that shows items and nearest neighbors to said items. See col. 3 line 62 to col. 4 line 17. However, there is no suggestion that content elements should be displayed at the same time.

The simultaneous display of identifiers and content elements is of particular importance for the preferred embodiment of the present invention, when judicial opinions are displayed. This is because the most common identifiers for such opinions are the case citation (e.g., 756 F.2d 912), providing little substantive information about the case, and making it particularly important to display some of the content itself along with the identifier to allow the user conducting legal research to make a judgment whether the case is useful for the topic being researched. In addition, it is important that the actual content of the case be used, not a summary or derived text, because users only can rely upon the actual words of the court, and not a summary that is determined by an editor or algorithm.

Since claims 2-20 (unamended) depend from claim 1 and claims 22-49 (unamended) depend from claim 21, these claims cannot be obvious if claims 1 and 21 are not obvious. As a result, the above shows that none of claims 1-49 should be rejected for obviousness under 35 U.S.C. § 103. Nonetheless, for completeness, the Applicant will herein respond to the specific citations that were provided by the Examiner to show the obviousness of the dependent claims.

In claim 2, the content element displayed is the entirety of the document. The portions of Barr cited by the examiner do not teach the display of any content element, as discussed above.

In claim 3, the identifiers are case citations. Barr does not deal with legal material at all. Fig. 4A shows a display with the title of a text or multi-media document, but does not teach including the unique legal citation that would correspond to a judicial opinion. For example, the title of a case could simply be deemed to be "U.S. v. Smith," whereas a proper citation could be 65 N.W.2d 395 (1987), for example. However, claim 3 teaches identifying the case not by its title, but by the uniform system of citation that is unique to legal materials and not discussed by either Barr or Schmitt.

Claims 4 and 5 (amended) teach identifying and marking records that were either responsive to a prior search request, or displayed as part of a prior search request. Element 206 of Fig. 2 of Barr teaches choosing an item from a results list, but nowhere implies tracking which items had been responsive or chosen before and does not address how any items would be displayed. Fig. 4A shows a display of various items, but does not teach identifying previously responsive or viewed items in any way.

Regarding claim 15, the Examiner cites a discussion of relevance sorting in Barr (col. 13, lines 30-67). Claim 15 adds the limitation that there is an additional step of resolving ties from a preceding sort. Barr teaches a single relevance sort and does not make any mention of how to handle situations where two records have the same relevance.

Regarding Claim 7, the examiner cites Barr Col. 13 lines 30-67. As discussed above, this passage teaches relevance sorting, but makes no mention of the identifiers and content elements that a record might include, such as those stated in claim 7. Claim 7 requires that the record contain a name, citation, date, and author.

Regarding claims 9-14, the Examiner cites Barr Fig. 5 and Schmitt Fig. 3 and col. 3 lines 22-44. Barr Fig. 5 lists preferred data structures, an image table, and a publisher information table, but makes no mention of sorting search results, as is required by the claims at issue. Fig. 3 of Schmitt illustrates the process of defining a domain model. It deals with a method of selecting results, but not a method of sorting results. Col. 3 lines 22-44 of Schmitt discusses the selection process taught by the patent, but does not mention sorting, as is taught by claims 9-14 of the present invention.


Regarding claims 16-20, the Examiner cites Bar figs. 4A and 5 and Schmitt Fig. 3. Claims 16 requires the identification of records that were displayed in a prior search. None of the cited art mentions identifying the records that have been previously displayed. Schmitt teaches a way of narrowing the search results, but does not identify previously identified records or display them differently in future results lists. Also, none of the cited art discusses the different ways that records can be identified, as is claimed by claims 17-20 of the present invention.

The Examiner states that the rejections of the apparatus claims 21-49 follow from the rejections of claims 1-20. The Applicant respectfully asserts that the arguments traversing the rejections of claims 1-20 should be applied to claims 21-49. The Applicant also notes that claims 21-49 contain additional elements not contained in claims 1-20 that further support a conclusion of non-obviousness. For example, claims 27-33 and 39 claim displays involving novel and non-obvious algorithms for sorting documents that were not addressed in the rejection.

For all of these reasons, the Examiner's rejection under 35 U.S.C. § 103 of Claims 1-49 as obvious over Barr in view of Schmitt is respectfully traversed. Applicants respectfully assert that all of these grounds of rejection should be withdrawn.

Applicants respectfully submit that the arguments submitted herein, in conjunction with the claim amendments, overcome or obviate each of the Examiner's objections and rejections and place Claims 1-73 in condition for allowance. Applicants concurrently file a request for a one-month extension of time to respond to the Examiner's Official Action and checks totaling \$691.00 to cover the \$55.00 fee for the extension of time (small entity) and the \$594.00 fee for new extra claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Philip J. Rosenthal", written over a horizontal line.

Philip J. Rosenthal
Reg. No. 42,114

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